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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,481	07/24/2003	Ceylan C. Guclu	GEMS8081.150-1	1480
27061	7590	08/12/2004	EXAMINER	
ZIOLKOWSKI PATENT SOLUTIONS GROUP, LLC (GEMS)			VARGAS, DIXOMARA	
14135 NORTH CEDARBURG ROAD			ART UNIT	
MEQUON, WI 53097			PAPER NUMBER	
			2859	

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s) 	
	10/604,481		GUCLU ET AL.	
	Examiner		Art Unit	
	Dixomara Vargas		2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, drawn to a phantom for MR, classified in class 324, subclass 308.
 - II. Claims 8-15, drawn to a method of manufacturing a phantom, classified in class 436, subclass 8.
 - III. Claims 16-22, drawn to a method of evaluating MR applications, classified in class 324, subclass 309.
 - IV. Claims 23-25, drawn to a kit to form human brain phantom, classified in class 424, subclass 9.3.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the phantom of group I does not requires composition of a first combination of paramagnetic powder, agarose powder, deuterium oxide, and water in a first set of interstitial cavities; and a second combination of paramagnetic powder, agarose powder, deuterium oxide, and water in a second set of interstitial cavities as required in group II. In addition, the phantom manufactured

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in group II does not requires being for emulating the MR properties of white and gray matter of the human brain as required in group I.

3. Inventions III and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the MR method of using the phantom in group III does not requires providing a phantom with a first section containing material to emulate the MR properties of white matter of a human brain, and a second section containing material to emulate the MR properties of gray matter of a human brain as required in group I.

4. Inventions IV and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the phantom of group I does not requires composition of a first and second combination of paramagnetic material, agarose material, deuterium oxide, and water as required in group IV.

5. Inventions III and II are related as process of making and process of using the product. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product used (2) that the product in the method of using a product as claimed can be made by another and materially different

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process (MPEP § 806.05(f)). In the instant case the phantom used in the MR method of group III does not requires a composition of a first combination of paramagnetic powder, agarose powder, deuterium oxide, and water in a first set of interstitial cavities; and a second combination of paramagnetic powder, agarose powder, deuterium oxide, and water in a second set of interstitial cavities as required in group II.

6. Inventions IV and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the phantom of group IV does not require water in the composition as required in group II. In addition, the method of manufacturing a phantom of group II does not require providing a first mixture with a proton density substantially equivalent to human brain white matter, and second mixture has a proton density substantially equivalent to human brain gray matter as required in group IV.

7. Inventions IV and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the phantom used in the method of group III does not require a composition of a first and second combination of paramagnetic material, agarose material and deuterium oxide; and providing a first mixture with a proton density substantially equivalent to

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human brain white matter, and second mixture has a proton density substantially equivalent to human brain gray matter as required in group IV.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

9. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

10. Because these inventions are distinct for the reasons given above and the search required for Group III is not required for Group I, restriction for examination purposes as indicated is proper.

11. Because these inventions are distinct for the reasons given above and the search required for Group IV is not required for Group I, restriction for examination purposes as indicated is proper.

12. Because these inventions are distinct for the reasons given above and the search required for Group III is not required for Group II, restriction for examination purposes as indicated is proper.

13. Because these inventions are distinct for the reasons given above and the search required for Group IV is not required for Group II, restriction for examination purposes as indicated is proper.

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14. Because these inventions are distinct for the reasons given above and the search required for Group IV is not required for Group III, restriction for examination purposes as indicated is proper.

15. A telephone call was made to Kent Baker on August 5, 2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

16. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

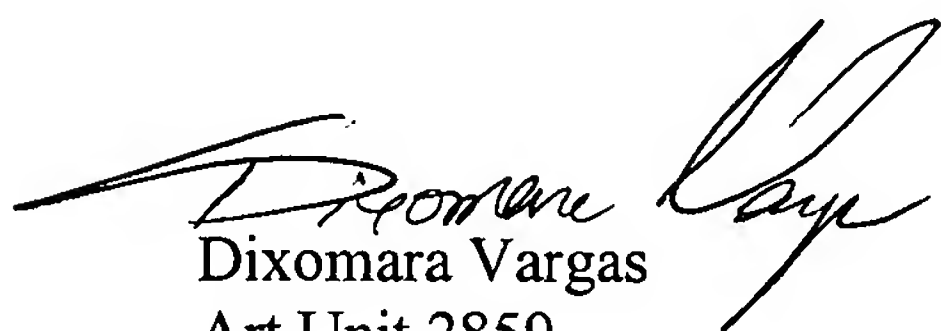
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dixomara Vargas whose telephone number is (571) 272-2252. The examiner can normally be reached on 8:00 am. to 4:30 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dixomara Vargas

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August 6, 2004



Diego Gutierrez

Supervisory Patent Examiner

Technology Center 2800

CHRISTOPHER W. FULTON
PRIMARY EXAMINER